

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jeffry Jovan Philyaw

Serial No.: 09/382,426

Filed: August 24, 1999

Group: 3625

Examiner: Mark A. Fadok

For: METHOD AND APPARATUS FOR COMPLETING, SECURING AND
CONDUCTING AN E-COMMERCE TRANSACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

Please consider the following reasons in support of the concurrently filed Pre-Appeal
Brief Request for Review.

In the final rejection mailed on April 5, 2007, claims 1-11, 14-17, 19-24 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,005,939 to *Fortenberry* (“*Fortenberry*”) in view of U.S. Patent No. 5,960,411 to *Hartman* (“*Hartman*”). Claims 13, 18, 26, 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fortenberry* in view of *Hartman* and further in view of U.S. Patent No. 6,311,214 to *Rhoads* (“*Rhoads*”).

In the present application, as explained in more detail below, the Examiner proposes various combinations of references without a proper suggestion or motivation to make each proposed modification. This means that the first criterion for a *prima facie* rejection has not been met, which in turn, means the Examiner has failed to carry the burden of establishing a *prima facie* rejection. In addition, certain claim limitations are not taught or suggested by the cited combinations, which

REASONS IN SUPPORT OF PRE-APPEAL
BRIEF REQUEST FOR REVIEW

means that the third criterion for a *prima facie* rejection has not been met and that the Examiner has failed to carry the burden of establishing a *prima facie* rejection for this independent reason.

I. No Suggestion or Motivation to Combine the References

A. Applicant submits that there is clear error with respect to the Examiner's rejection of claims 1-11, 14-17, 19-24 and 27 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,005,939 to *Fortenberry* ("Fortenberry") in view of U.S. Patent No. 5,960,411 to *Hartman* ("Hartman"). As detailed at length on pages 7-16 of Applicant's Response (filed May 21, 2007, in response to the Final Office Action dated April 5, 2007), the rejections of claims 1-11, 14-17, 19-24, and 27 are deficient because there is no motivation to combine the references. In fact, as detailed in the Response, the text cited by the Examiner not only fails to support the combination, but frequently teaches away from such a combination.

As Applicant states in the Response dated May 21, 2007, there are some differences between the claim language and the operation as disclosed by *Fortenberry*. First, Claims 1 and 14 of the instant application require entering profile information into a profile form. The claims also require issuing to the user, a unique code in response to the user transmitting the profile form to a second location on the network. *Fortenberry* does not teach or suggest profile information entered into a profile form forwarded to the second location which, in response thereto, results in the transmission to the user of a unique code. *Fortenberry* teaches profile information is entered directly into the website of the passport agent and, after entry of the information; a unique code in the form of a public key is then forwarded to the user. The third element of the claims requires initiating an online transaction by selecting a product of the vendor at a user location. However, *Fortenberry* does not set forth specifically that an on-line transaction is initiated by "selecting" a product of a vendor at a user location. *Fortenberry* only discloses that the user "requests a transaction with a particular vendor" (column 8, lines 29-30). Applicant previously responded that the claim requires that the stored profile information be provided from the second location to the vendor location "in response to" the vendor location receiving and processing the code. *Fortenberry* discloses a process whereby the "user requests passport agent to send passport to vendor" (Col. 8, lines 34-36). The vendor location does not process the code. The unique code in *Fortenberry* is a public key only utilized to

REASONS IN SUPPORT OF PRE-APPEAL
BRIEF REQUEST FOR REVIEW

enable the vendor to read the stored information once the information has been received by the vendor. Therefore, the portion of the claim that states “in response to” with respect to the step of providing cannot be met by *Fortenberry*. *Fortenberry* is concerned with identifying the user prior to going forward with the transaction as compared to Applicants claim which utilizes the information, i.e., the stored profile information, for *completing the transaction*.

Further, the claim requires that the stored profile information be provided to the vendor “in response to the vendor location receiving and processing the unique code.” There is no suggestion or teaching in *Fortenberry* that would lead one skilled in the art to change the operation wherein the user in *Fortenberry* sends a public key to the vendor and then sends a request to the passport agent to send the passport to the vendor to allow a previously requested transaction to go forward. The claim clearly requires that the stored profile information is a function of the vendor location receiving and processing the unique code. However, in *Fortenberry*, the vendor location will not even utilize the unique code until it receives the profile information. Thus, the profile information is not only received separately, but, contrary to the claims of the instant application, must be received prior to any use of the unique code.

The Examiner has provided *Hartman* to cure the deficiency in *Fortenberry*. The Examiner is using *Hartman* to teach inserting released information into a form automatically before submittal to a user. Applicant previously illustrated that, in *Hartman*, the information is inserted into the web page with the description of the product prior to the user deciding to select that particular product. However, the claim, as currently presented, requires the selection to have already been made, and the providing of the unique code is performed during the on-line transaction. Furthermore, Applicant previously detailed the deficiencies of *Hartman* with respect to the various elements of the claims. The Examiner has indicated that the arguments over *Hartman* were moot in view of the new grounds of rejection. However, including the confirmation page of *Hartman* in *Fortenberry* ignores all of the limitations and the order of steps which were set forth in the prior Responses filed by Applicant. One of the deficiencies was the fact that the webpage presented to the user was presented upon the user’s physical device accessing the vendor’s location such that a “cookie” could be interfaced with. This information is set at the time of access and not after ordering a product or after

REASONS IN SUPPORT OF PRE-APPEAL
BRIEF REQUEST FOR REVIEW

sending the unique code thereto. Thus, the steps require that, before the filled in form is sent to the user, there be a product selected, a unique code sent thereafter and this unique code utilized to complete the transaction. In *Hartman*, the only information provided to the user before the single-action operation is that associated with the purchaser such that the purchaser can verify that the service system correctly recognizes the purchaser. (*Hartman*, col. 4, lines 37-40.) However, this information is not utilized for the purpose of providing to the user a filled in form. In fact, *Hartman* teaches away from providing the user a filled in form; rather, *Hartman* teaches the use of a single-action operation wherein the complete transaction is made without providing to the user a form. The only form is that in Fig. 1c which is provided to the user "after" the transaction has been completed. This is contrary to the purpose of Applicants present inventive concept, which is to provide to the user a filled in form that the user can view "prior to completion of the on-line transaction."

B. Applicant submits that there is clear error with respect to the Examiner's rejection of claims 13, 18, 26, 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fortenberry* in view of *Hartman* and further in view of U.S. Patent No. 6,311,214 to *Rhoads* ("Rhoads"). More specifically, as detailed at length on pages 15-16 of Applicant's Response (filed on May 21, 2007 in response to the Final Office Action dated April 5, 2007), the rejections of claims 13, 18, 26, 28 and 29 are deficient because the deficiencies in the combination of *Fortenberry* and *Hartman* are not cured by the addition of *Rhoads*. In fact, as detailed in the Response, the text cited by the Examiner not only fails to support the combination, but frequently teaches away from such a combination.

II. Even When Combined, the References Fails Teach or Suggest All Claim Limitations

On pages 7-14 of the Amendment After Final, Applicant has illustrated the failure of the references to teach all claim limitations in the previously filed responses. For Example, on pages 8-12, Applicant states why the *Fortenberry* Reference fails to teach or suggest that any information is entered into "profile form" or that any profile form is "transmitted" from a user location to a second location on the network. Applicant shows why the combination of *Fortenberry* and *Hartman* fails to teach: there is not step of initiating an online transaction by selecting a product; a unique code

REASONS IN SUPPORT OF PRE-APPEAL
BRIEF REQUEST FOR REVIEW

“representing” the stored profile information; the stored information is not provided to the vendor “in response to” the vendor location receiving and processing the code; and the vendor does not “process the unique code” in order to receive the stored profile information.

Conclusion

Applicant submits that not only do the combined references fail to teach or suggest all claim limitations as required, but that the text cited by the Examiner from the various references fails to provide a suggestion or motivation for the various combinations because the text fails to illustrate “why” one skilled in the art would combine the references in the particular manner required. Instead, the text simply identifies particular components for each reference, combines them in a specific manner required by Applicant’s claimed invention, and then states that it would be obvious to one skilled in the art to do so. This is clearly hindsight based reasoning that contravenes the standards imposed by both the MPEP and the Federal Circuit, and Applicant respectfully requests that the rejections under § 103 be withdrawn.

It is respectfully submitted that all the claims in the application are in condition for allowance.

Respectfully submitted,
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October 5, 2007

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

PHLY-24,732

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Signature _____

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Application Number

09/382,426

Filed
August 24, 1999

First Named Inventor

JEFFRY JOVAN PHILYAW

Art Unit

3625

Examiner

MARK A. FADOK

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

/Gregory M. Howison Reg. #30646/

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Typed or printed name

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972-479-0462

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Registration number if acting under 37 CFR 1.34 _____

October 5, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

*Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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